

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : BAKER, Matthew P.J.

Serial No. : 10/728,266

Filed : December 04, 2003

Atty. Docket : B 034320USA

Examiner : MUI, Gary

Group Art Unit : 2416

Confirmation No. : 7101

Mail Stop Issue Fee

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Sir:

In the Notice of Allowability, the Examiner set forth various reasons for allowance and made certain allegations pertaining to claims and/or references.

It is hereby submitted that Applicant does not concede, acquiesce or admit the positions taken in the examiner's statement of reasons for allowance.

It is further submitted that the record of the prosecution *as a whole* makes clear the reasons for allowing a claim or claims. Namely, the examiner's actions and the applicant's replies during the prosecution made evident the reasons for allowance, satisfying the "record as a whole" proviso of the rule. The examiner's actions clearly pointed out the reasons for rejection and the applicant's reply explicitly presented reasons why claims are patentable over the reference. Hence, it is believed that the reasons for allowance were evident from the record, and no statement was necessary.

As further explicitly stated in MPEP 1302.14, it is improper to use a statement of reasons for allowance to attempt to narrow a claim by providing a special definition to a claim limitation which is argued by Applicant, but not supported by a special definition in the description in cases where the ordinary meaning of the term in the prior art demonstrates that the claim remains unpatentable for the reasons of record, and where such claim narrowing is only tangential to patentability. Cf. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741, 62 USPQ2d 1705, 1714 (2002).

Still further according to MPEP 1302.14, the examiner's statement of reasons for allowance is the personal opinion of the examiner as to why the claims are allowable. In accordance with the Festo court, the examiner's statement should not create an estoppel, and only applicant's statements can create an estoppel. The failure of applicant to comment on the examiner's statement of reasons for allowance should not be treated as acquiescence to the examiner's statement. Any inferences or presumption are to be determined on a case-by-case basis by a court reviewing the patent, the USPTO examining the patent in a reissue application or a reexamination proceeding, the Board of Patent Appeals and Interferences reviewing the patent in an interference proceeding, etc.

Respectfully submitted,

February 6, 2009

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